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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212258
Party	Plaintiff Top Tobacco L.P.
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Signature	/Antony McShane/
Date	12/16/2013
Attachments	Motion_to_Strike_for_P_O_P__Tabacalera_.pdf(10816 bytes) Memo_in_Support_of_Motion_to_Strike_AFfirmative_Defenses_P_O_P.pdf(23902 bytes) POP Exhibits.pdf(151793 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Top Tobacco, L.P. Opposer v. Tabacalera El Artista S.R.L.. Applicant	Opposition No. 91212258 Mark: P.O.P Serial No. 85/798,713

OPPOSER'S MOTION TO STRIKE AFFIRMATIVE DEFENSES

Opposer Top Tobacco, L.P., pursuant to Federal Rule of Civil Procedure 12(f), hereby moves this Board for an order striking Applicant's nine purported Affirmative Defenses set forth in its Answer. As set forth more fully in the Memorandum of Law filed simultaneously herewith, each of Applicant's Affirmative Defenses is legally deficient. Applicant asserts claims - namely acquiescence, laches and estoppel- that cannot stand as a matter of law because Top Tobacco could not have delayed in bringing this action. In addition, Applicant also asserts boilerplate, conclusory statements that fall in the face of *Iqba1* and *Twombly*, as each allegation lacks any specific fact and, as such, fails to put Top Tobacco on notice of the underlying bases for the purported defenses or claims, as required by Federal Rule of Civil Procedure 8. Compliance with *Iqba1* and *Twombly* and other legal precedent requires that these types of perfunctory bare-boned, conclusory allegations are stricken from pleadings.

Unless stricken, each of Applicant's purported Affirmative Defenses will clutter the case with impertinent allegations and require unnecessary discovery and motion practice. Granting the present motion will, therefore, serve the interests of the parties and the Board by removing

irrelevant and unnecessary issues from the proceeding and allow this case to move forward in an efficient and focused manner.

WHEREFORE, Top Tobacco, L.P. respectfully requests that the Board:

(1) enter an Order granting its Motion and striking each of Applicant's Affirmative Defenses;

(2) grant Top Tobacco, L.P. any such additional and further relief that the Board deems proper.

Date: December 16, 2013

Respectfully submitted,

/Antony J. McShane/
One of the Attorneys for Opposer
Top Tobacco, L.P.

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CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **OPPOSER'S MOTION TO STRIKE AFFIRMATIVE DEFENSES** upon:

Darren S. Rimer
Rimer & Mathewson LLP
30021 Tomas, Suite 300
Rancho Santa Margarita, California, 92688

by depositing said copy in a properly addressed envelope, First Class postage prepaid, and depositing same in the United States mail at Two North LaSalle Street, Chicago, Illinois, on the date noted below:

Date: December 16, 2013

/Andrea S. Fuelleman/
One of the Attorneys for Opposer,
Top Tobacco, L.P.

NGEDOCS: 2136140.3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Top Tobacco, L.P. Opposer v. Tabacalera El Artista S.R.L.. Applicant	Opposition No. 91212258 Mark: P.O.P Serial No. 85/798,713

MEMORANDUM OF LAW IN SUPPORT OF OPPOSER'S
MOTION TO STRIKE AFFIRMATIVE DEFENSES

In its Answer to Opposer's Notice of Opposition, Applicant asserted nine purported defenses that are fatally flawed in that each is a "bare boned" conclusory statement that fails to comply with Rule 8 of the Federal Rules of Civil Procedure and the dictates of *Iqbal* and *Twombly,* is legally unattainable and/or merely a restatement of Applicant's denial of Top Tobacco's allegations. Unless stricken, each of Applicant's purposed Affirmative Defenses will clutter the case with impertinent allegations, require unnecessary discovery and motion practice and unnecessarily increase the time and expense of discovery. Accordingly, pursuant Rule 12(f) of the Federal Rules of Civil Procedure, Top Tobacco moves this Board for an Order striking Applicant's Affirmative Defenses.

I. EACH OF APPLICANT'S NINE AFFIRMATIVE DEFENSES IS FATALLY FLAWED

Motions to strike should be granted when they remove unnecessary clutter from the case, and therefore expedite rather than delay the proceedings. *Heller Fin., Inc. v. Midwhey Powder Co.*, 883 F.2d 1286, 1294 (7th Cir. 1989). An affirmative defense must raise matters that are distinct from, and not merely denials of, the elements of the opposing party's claims. *Tarifold v. Nelson,* No. 99-c-194, 1999 U.S. Dist. LEXIS 16426, at *3 (N.D. Ill. October 14, 1999). Moreover, it is axiomatic that Rule 12 requires that an affirmative defense be: (1) a cognizable

affirmative defense; and (2) pled in compliance with Rule 8 of the Federal Rules of Civil Procedure and the dictates of *Iqbal* and *Twombly*. *Bobbitt v. Victorian House, Inc.*, 532 F. Supp. 734, 737 (N.D.Ill. 1982). Indeed, Rule 8 requires that affirmative defenses must do more than merely assert bare bones, conclusory allegations that fail to put party on notice of the underlying bases for the purported defenses. *See Linc. Fin. Corp. v. Onwuteaka*, No. 95C4928, 1995 WL 708575, at *3 (N.D. Ill. Nov. 30, 1995) (holding that if an affirmative defense contains no more than "bare bones conclusory allegations," it must be stricken). Similarly, compliance with *Iqbal* and *Twombly* requires that pleadings show plausible factual allegations that, if accepted as true, "state a claim to relief that is plausible on its face." *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). As outlined below, all of Defendant's nine affirmative defenses should be stricken.

A. Affirmative Defense Nos. 1, 2, 3 and 4 are Legally Untenable and Should be Stricken.

The most obviously deficient of Applicant's Affirmative Defenses are those that, in one form or another, are legally untenable. In Applicant's First Affirmative Defense, Applicant alleges nothing more than that the "Opposition fails to state grounds on which relief can be granted." *See* Answer at ¶ 7. The Board has repeatedly stricken such a "defense" where, as here, the opposer has alleged facts that, if proved, would establish that "(1) the opposer has standing to maintain the proceeding, and (2) a valid ground exists for opposing registration." *See S.C. Johnson & Son, Inc. v. GAF Corp*., 177 USPQ 720, 721 (TTAB 1973) (striking defense of failure to state a claim upon which relief could be granted where Opposer alleged likelihood of confusion with its prior registered mark). Top Tobacco certainly has standing, as evidenced by its use and registrations of its Top marks, as pled in the Notice of Opposition. *See*, Notice of Opp. at ¶¶ 2-4. Top Tobacco also has alleged a likelihood of confusion in violation of 15 U.S.C. §1052(d) and that it will be harmed by the issuance of a registration for the subject marks to

Respondent. *Id*. at ¶ 6. Top Tobacco's pleading, therefore, is legally sufficient in establishing standing and stating a claim.

Additionally, Applicant's Second, Third, and Forth Defenses - acquiescence, laches, estoppel – are deficient because Top Tobacco, as a matter of law, could not have delayed in bringing this action. *See National Cable Television Ass'n Inc. v. American Cinema Editors Inc.*, 19 USPQ2d 1424, 1431-32 (Fed. Cir. 1991) (re-affirming precedent that laches is measured "from the time the action could be taken against the acquisition by another of a set of rights…"). Applicant filed the subject application on December 10, 2012 and alleges a first use date of November 5, 2012. (*See* Trademark Electronic Search System (TESS) printouts for the subject application, attached hereto as Exhibit A). Soon after the subject application published in the Official Gazette—on May 7, 2013—Top Tobacco filed the appropriate extensions of time with the Board in which to file its Notice of Opposition. Top Tobacco was granted until September 4, 2013 to oppose the application. *See*, Orders Granting Ext. of Time (attached hereto as Exhibit B). On September 3, 2013, Top Tobacco timely filed its Notice of Opposition in this proceeding.

The Court of Appeals for the Federal Circuit has explicitly held that that laches and estoppel cannot apply where, as here, an Opposer acts at its first opportunity to protest the issuance of a registration – namely, when the mark is published for opposition. *National Cable Television Ass'n Inc.*, 19 USPQ2d at 1431-32 (re-affirming precedent that laches is measured "from the time the action could be taken against the acquisition by another of a set of rights…"). *See also, Panda Travel Inc. v. Resort Option Enterprises Inc.*, 94 USPQ2d 1789, 1797 (TTAB 2009) ("Because opposer timely filed notices of opposition, there has been no undue delay by opposer or prejudice to applicant caused by opposer's delay"). Thus, Applicant's Affirmative Defenses should be stricken.

B. Affirmative Defense Nos. 1, 2, 3, 4, 5, 6, 7, 8, and 9 Should be Stricken Because They Are Not in Compliance with *Iqbal* and *Twombly*.

None of Applicant's nine Affirmative Defenses — failure to state a claim, acquiescence, laches, etoppel, failure to adequately maintain its marks, strength of marks, abandonment, no likelihood of confusion and no actual confusion — allege a single specific fact. *See* Answer at ¶¶ 7-15. Instead, each of Applicant's nine Affirmative Defenses are perfunctory bare-boned, conclusory allegations that fail to put Opposer on notice of the underlying basis for the purported defenses or claims, as required by Federal Rule of Civil Procedure 8 and the dictates of *Iqbal* and *Twombly*. Allegations that fail to meet this clear and well-established standard, like those asserted by the Applicant, must be stricken. *See Linc. Fin. Corp. v. Onwuteaka*, No. 95C4928, 1995 WL 708575, at *3 (N.D. Ill. Nov. 30, 1995) (holding that if an affirmative defense contains no more than "bare bones conclusory allegations," it must be stricken); *Shah v. Colleto, Inc*., No. DKC 2004-4059, 2005 U.S. Dist. LEXIS 19938, at *12 (D. Md. Sept. 12, 2005) (noting that the court "need not…accept unsupported legal allegations, legal conclusions couched as factual allegations or conclusory factual allegations devoid of any reference to actual events" under pleading standard of Rule 8).

Another reason that at least some predicate facts are required is illustrated by Applicant's allegations themselves, as Applicant alleges estoppel, for example, which is found when Applicant relies upon an affirmative act by Opposer. *Television Ass'n Inc. v. American Cinema Editors Inc*., 19 USPQ2d 1424, 1431-32 (Fed. Cir. 1991). Rule 8 requires that an applicant allege what that act is, who did it, and when and where the act occurred so that an opposer can defend the allegations at trial. Here, in its Forth Affirmative Defense, Applicant fails to allege a single fact and instead merely alleges that "Opposer is barred from relief by the Doctrine of Estoppel." *See* Answer at ¶ 10.

Similarly, acquiescence and laches require Applicant to allege facts to which, if proved, would establish Opposer's undue delay in asserting rights against a claimant to a conflicting mark, and prejudice resulting therefrom. *Land O' Lakes Inc. v. Hugunin*, 88 USPQ2d 1957, 1959 (TTAB 2008) (the defense of laches "requires factual development" to establish undue delay). Rather, Applicant merely alleges that "Opposer is barred from relief by the Doctrine of Acquiescence" and "Opposer is barred from relief by the Doctrine of Laches." *See* Answer at ¶¶ 8-9. Accordingly because none of the Affirmative Defenses allege a single fact that, if proven, could support a plausible defense, each of Applicant's nine Affirmative Defenses should be stricken.

C. Affirmative Defense Nos. 5, 6, 7 and 8 Should be Stricken Because They are Not Recognized Defenses and are Redundant.

Applicant's Fifth, Sixth, Seventh and Eighth Affirmative Defenses — for failure to adequately maintain its marks, strength of marks, abandonment and no likelihood of confusion — are not recognized affirmative defenses. *See* Answer at ¶¶ 11-14. Rather, these serve only as general denials of Opposer's claim, and are redundant of the denials contained in the answer. Applicant's repetition of its earlier denials as affirmative defenses is not necessary and serves no purpose other than to clutter these proceedings. *See Textron, Inc v. The Gillette Co.*, 180 USPQ 152, 154 (TTAB 1973) (finding assertions improperly pled as they merely reaffirm respondent's previous denial of opposer's claim of likelihood of confusion).

While it has been held that merely redundant defenses have been allowed to stand in some limited circumstances, *see Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995), permitting redundant defenses is bad practice and the proper, and more frequently applied rule is to strike defenses that fail to add any substance to Applicant's prior denial of Opposer's claim. *See Textron, Inc v. The Gillette Co.*, 180 USPQ

152, 154 (TTAB 1973). Such defenses are redundant in character and therefore improperly plead and should be stricken.

II. STRIKING APPLICANT'S NINE PURPORTED AFFIRMATIVE DEFENSES WILL SERVE THE INTERESTS OF THE PARTIES AND THE BOARD

If these defenses are permitted to stand, Top Tobacco will be forced to serve numerous discovery requests and dedicate substantial deposition time, not only to discover the basis of Applicant's Affirmative Defenses, but also to prepare Top Tobacco's responses to these defenses. Granting the present motion will, therefore, serve the interests of the parties and the Board by removing irrelevant and unnecessary issues from the proceeding and allow this case to move forward in an efficient and focused manner. *Garlanger v. Verbeke*, 223 F. Supp. 2d 596, 609 (D.N.J. 2002).

III. CONCLUSION

Each of Applicant's nine Affirmative Defenses is legally deficient. Compliance with *Iqbal* and *Twombly*, Rule 8 of the Federal Rules of Civil Procedure and other legal precedent require striking these types of deficient claims and defenses from pleadings.

WHEREFORE, Top Tobacco, L.P. respectfully requests that the Board:

(1) enter an Order granting its Motion and striking each of Applicant's Affirmative Defenses;

(2) grant Top Tobacco, L.P. any such additional and further relief that the Board deems proper.

Date: December 16, 2013

Respectfully submitted,

/Antony J. McShane/
One of the Attorneys for Opposer
Top Tobacco, L.P.

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CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **MEMORANDUM OF LAW IN SUPPORT OF OPPOSER'S MOTION TO STRIKE AFFIRMATIVE DEFENSES** upon:

Darren S. Rimer
Rimer & Mathewson LLP
30021 Tomas, Suite 300
Rancho Santa Margarita, California, 92688

by depositing said copy in a properly addressed envelope, First Class postage prepaid, and depositing same in the United States mail at Two North LaSalle Street, Chicago, Illinois, on the date noted below:

Date: December 16, 2013

/Andrea S. Fuelleman/
One of the Attorneys for Opposer,
Top Tobacco, L.P.

NGEDOCS: 2138865.1

EXHIBIT A

TESS was last updated on Mon Dec 16 03:10:34 EST 2013

Record 1 out of 1

P.O.P.

Word Mark	P.O.P.
Goods and Services	IC 034. US 002 008 009 017. G & S: Cigars. FIRST USE: 20121105. FIRST USE IN COMMERCE: 20121105
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	85798713
Filing Date	December 10, 2012
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	May 7, 2013
Owner	(APPLICANT) Tabacalera El Artista S.R.L. CORPORATION DOMINICAN REP www.elartista.com.do PRESIDENTE VASQUEZ 115 TAMBORIL, SANTIAGO DOMINICAN REP
Attorney of Record	Darren S. Rimer
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

EXHIBIT B

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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PRESIDENTE VASQUEZ 115
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TAMBORIL SANTIAGO
DOMINICAN REPUBLIC

Mailed: June 6, 2013

Serial No.: 85798713

Lalita Greer, Paralegal Specialist:

The request to extend time to oppose is granted until **7/6/2013** on behalf of potential opposer **Top Tobacco L.P.**

Please do not hesitate to contact the Trademark Trial and Appeal Board for any questions relating to this extension.

New Developments at the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at http://estta.uspto.gov. Images of TTAB proceeding files can be viewed using TTABVue at http://ttabvue.uspto.gov.

TRADEMARK TRIAL AND APPEAL BOARD RULE CHANGES

The USPTO has issued new rules pertaining to TTAB proceedings. Parties are urged to familiarize themselves with the new rules.

Among other changes, for any notice of opposition filed on or after November 1, 2007, the new rules require an opposer to provide proof of service of the notice of opposition upon the applicant at the time the notice of opposition is filed. Trademark Rule 2.101. (Parallel amendments to Trademark Rule 2.111 require a petitioner to include proof of service of the petition for cancellation.) Service may be made by any of the means set out in Trademark Rule 2.119(b). A certificate of service is adequate proof of

service; service by a process server is not necessary. A notice of opposition (or petition for cancellation) filed without a certificate of service will not be instituted.

The notice of final rulemaking and a chart summarizing the changes contained in the notice are available for viewing on the TTAB web page:

www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf
www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

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Mailed: July 11, 2013

Serial No.: 85798713

Lalita Greer, Paralegal Specialist:

The request to extend time to oppose is granted until **9/4/2013** on behalf of potential opposer **Top Tobacco L.P.**

Please do not hesitate to contact the Trademark Trial and Appeal Board for any questions relating to this extension.